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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/881,702	06/18/2001	Gilles Chriqui	Q64917	8603

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EXAMINER

SHOSHO, CALLIE E

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 10/08/2002

3

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/881,702

763
Applicant(s)

CHRIQUI, GILLES

Examiner

Callie E. Shosho

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in France on 6/19/00. It is noted, however, that applicant has not filed a certified copy of the French application as required by 35 U.S.C. 119(b).

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(a) Claim 1 recites basic mixture containing chlorinated polyolefin, mineral filler, and treating agent for filler, "an said amino-silane". The scope of the claim is confusing because it is not clear if the basic mixture comprises the amino-silane. Also in the cited phrase should "an" be changed to "and"?

(b) Claim 2 recites that the silane treating agent is "substantially" inert relative to chlorinated polyolefin. The scope of the claim is confusing because it is not clear what is meant by "substantially". Can the silane react with the chlorinated polyolefin? To what extent?

Clarification is requested.

(c) Claim 9 recites that the basic mixture is "transformed". The scope of the claim is confusing because it is not clear what is meant by "transformed". Also, it is not clear how the mixture is transformed. What changes must occur to the mixture to consider it transformed? Clarification is requested. It is noted that similar questions arise with respect to claims 11 and 12 which also recite the phrase "transformed".

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
5. Claims 1-2, 4-5, and 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Keogh (U.S. 4,407,992) in view of EP 721001.

Keogh discloses an extrudable, curable, flame retardant composition comprising 5-20% chlorinated polyolefin, 2.5-12% filler including magnesium hydroxide and calcium carbonate,

i.e. chalk, which is coated with silane, and 0.5-15% antimony oxide. The ingredients are mixed at temperature of 120 °C and extruded using extruder, which would intrinsically possess hopper (col.1, line 64-col.2, line 4, col.3, lines 8, 31-38, and 50-60, col.4, lines 6-9, 39-42, and 64-66, and col.5, lines 6-9). It is calculated that the ratio of filler to chlorinated polyolefin is 0.125 (2.5/20) to 2.4 (12/5).

The difference between Keogh and the present claimed invention is the requirement in the claims of (a) aminosilane and (b) order in which the ingredients are mixed.

With respect to difference (a), EP 721001 discloses composition comprising chlorinated polyolefin and aminosilane in order to produce composition with long pot life and excellent heat resistance after curing (page 2, lines 9-11, page 3, lines 3-8 and 32-35, and col.4, lines 29-33). Given that the disclosure of Keogh in view of EP 721001 discloses composition identical to that presently claimed, it is clear that such composition would intrinsically be resistant to oil as presently claimed.

In light of the motivation for using aminosilane disclosed by EP 721001 as described above, it therefore would have been obvious to one of ordinary skill in the art to use aminosilane in the composition of Keogh in order to produce composition with long pot life and excellent heat resistance after curing, and thereby arrive at the claimed invention.

With respect to argument (b), it is noted that neither Keogh nor EP 721001 disclose mixing chlorinated polyolefin and treated filler first followed by adding aminosilane.

However, although the manner in which Keogh in view of EP 721001 introduces the ingredients into the composition is different than that presently claimed, given that the end result is the same, i.e. composition comprising chlorinated polyolefin, treated filler, and aminosilane,

and absent evidence of criticality regarding the order of introduction of the ingredients into the composition, it therefore would have been obvious to one of ordinary skill in the art (i) to mix the ingredients in any order, including that presently claimed, and (ii) that the final composition of Keogh in view of EP 721001 is the same as presently claimed, and thus, one of ordinary skill in the art would have arrived at the claimed invention.

6. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Keogh in view of EP 721001 as applied to claims 1-2, 4-5, and 8-10 above, and further in view of Nitta et al. (U.S. 6,075,086).

The difference between Keogh in view of EP 721001 and the present claimed invention is the requirement in the claims of amount of treating agent for filler.

Keogh discloses that the filler is covered with silane treating agent, however, there is no disclosure regarding the amount of treating agent used.

Nitta et al., which is drawn to polyolefin resin composition, disclose the use of filler such as magnesium hydroxide and calcium carbonate, which are surface-treated with silane in order to improve mixing property, molding properties, self-tapping strength, and weld strength of the composition (col.3, line 56-col.4, line 30).

In light of the disclosure of Nitta et al. as described above, it therefore would have been obvious to one of ordinary skill in the art to choose amounts of treating agent, including those presently claimed, in Keogh in order to produce composition with desired mixing and molding properties as well as strength, and thereby arrive at the claimed invention.

7. Claims 6-7 and 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Keogh in view of EP 721001 as applied to claims 1-2, 4-5, and 8-10 above, and further in view of Schombourg et al. (U.S. 6,448,343).

The difference between Keogh in view of EP 721001 and the present claimed invention is the requirement in the claims of auxiliary polymer.

Schombourg et al., which is drawn to composition comprising chlorinated polyolefin and aminosilane, disclose using porous polymer as carrier for the silane so that it is much easier to add the silane to the polymer during mixture (col.5, lines 45-52).

In light of the motivation for using auxiliary polymer disclosed by Schombourg et al. as described above, it therefore would have been obvious to one of ordinary skill in the art to use such polymer in the composition of Keogh in order to produce a composition which is easily mixed, and thereby arrive at the claimed invention.

8. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Keogh in view of EP 721001 as applied to claims 1-2, 4-5, and 8-10 above, and further in view of Ruepping (U.S. 6,346,300).

The difference between Keogh in view of EP 721001 and the present claimed invention is the requirement in the claims of temperature at which extrusion occurs.

Ruepping, which is drawn to curable elastomer composition comprising chlorinated polyolefin, disclose extruding such composition at 25-250 °C in order that the composition is thermally stable during the extrusion process and does not prematurely cure (col.6, lines 42-49 and col.11, line 62).

In light of the motivation for extruding at specific temperature disclosed by Ruepping as described above, it therefore would have been obvious to one of ordinary skill in the art to extrude the composition of Keogh at such temperature in order that the composition is thermally stable during the extrusion process, and thereby arrive at the claimed invention.

9. Claims 1-5 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Igarashi et al. (U.S. 5,149,732) in view of Keogh (U.S. 4,407,992) and either Nitta et al. (U.S. 6,075,086) or Abe et al. (U.S. 5,296,273).

Igarashi et al. disclose composition comprising 100 parts chlorinated polyolefin, 3-300 parts filler such as alumina hydrate and calcium carbonate, and aminosilane (col.4, lines 17, 36-37, 52-58, and 66 and col.5, lines 14-19). It is calculated that the ratio of filler to chlorinated polyolefin is 0.03 (3/100) to 3 (300/100).

The difference between Igarashi et al. and the present claimed invention is the requirement in the claims of (a) treating agent for filler and (b) antimony compound.

With respect to difference (a), Nitta et al., which is drawn to polyolefin resin composition, disclose the use of filler such as magnesium hydroxide and calcium carbonate, which are surface-treated with silane in order to improve mixing property, molding properties, self-tapping strength, and weld strength of the composition (col.3, line 56-col.4, line 30).

Alternatively, Abe et al., which is drawn to polyolefin resin molding composition, disclose the use of filler that is treated with silane in order to increase the dispersability of the filler (col.8, lines 20-33).

Although there is no disclosure in either Nitta et al. or Abe et al. of the amount of treating agent used, it would have been obvious to one of ordinary skill in the art to choose amount of treating agent, including those presently claimed, in order to produce composition with desired properties, or alternatively, suitable dispersability.

Further, given that the disclosure of Igarashi et al. in view of either Nitta et al. and Abe et al. discloses composition identical to that presently claimed, it is clear that such composition would intrinsically be extrudable, curable, and resistant to oil as presently claimed.

In light of the motivation for using treating agent for filler disclosed by either Nitta et al. or Abe et al. as described above, it therefore would have been obvious to one of ordinary skill in the art to use such treating agent with the filler of Igarashi et al. in order to produce composition with desired mixing and molding properties as well as strength, or alternatively, good dispersability, and thereby arrive at the claimed invention.

With respect to difference (b), Keogh, which is drawn to composition comprising chlorinated polyolefin and filler, disclose the use of 0.5-15% antimony oxide (col.2, lines 2-4 and col.4, lines 6-9), which is well known as a fire retardant.

In light of the above, it therefore would have been obvious to one of ordinary skill in the art to use antimony compound in composition of Igarashi et al. in order to produce composition that is fire retardant, and thereby arrive at the claimed invention.

10. Claims 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Igarashi et al. in view of Keogh and either Nitta et al. or Abe et al. as applied to claims 1-5 and 8 above, and further in view of Schombourg et al. (U.S. 6,448,343).

The difference between Igarashi et al. in view of either Keogh and Nitta et al. or Abe et al. and the present claimed invention is the requirement in the claims of auxiliary polymer.

Schombourg et al., which is drawn to composition comprising chlorinated polyolefin and aminosilane, disclose using porous polymer as carrier for the silane so that it is much easier to add the silane to the polymer during mixture (col.5, lines 45-52).

In light of the motivation for using auxiliary polymer disclosed by Schombourg et al. as described above, it therefore would have been obvious to one of ordinary skill in the art to use such polymer in the composition of Igarashi et al. in order to produce a composition which is easily mixed, and thereby arrive at the claimed invention.

11. Claims 1-5 and 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Coaker et al. (U.S. 5,036,121) in view of EP 721001 and either Nitta et al. (U.S. 6,075,086) or Abe et al. (U.S. 5,296,273).

Coaker et al. disclose extrudable, curable, flame retardant composition comprising 10-100 phr chlorinated polyolefin, 2-20 phr antimony oxide, and no more than 75 phr filler such as hydrated aluminum oxide and calcium carbonate, i.e. chalk. The ingredients are mixed at 60-70 °C and extruded using extruder, which would intrinsically possess hopper (col.5, lines 3-15 and 32-36, col.9, lines 31-41, col.11, lines 41-42, col.11, line 64-col.12, line 2, col.12, lines 48-50, and col.15, lines 24-25). It is calculated that the ratio of filler to chlorinated polyolefin is 0.75 (75/100) to 7.5 (75/10).

The difference between Coaker et al. and the present claimed invention is the requirement in the claims of (a) aminosilane, (b) treating agent for filler, and (c) order of mixing ingredients.

With respect to difference (a), EP 721001 discloses composition comprising chlorinated polyolefin and aminosilane in order to produce composition with long pot life and excellent heat resistance after curing (page 2, lines 9-11, page 3, lines 3-8 and 32-35, and col.4, lines 29-33).

With respect to argument (b), Nitta et al., which is drawn to polyolefin resin composition, disclose the use of filler such as magnesium hydroxide and calcium carbonate, which are surface-treated with silane in order to improve mixing property, molding properties, self-tapping strength, and weld strength of the composition (col.3, line 56-col.4, line 30).

Alternatively, Abe et al., which is drawn to polyolefin resin molding composition, disclose the use of filler that is treated with silane in order to increase the dispersability of the filler (col.8, lines 20-33).

Although there is no disclosure in either Nitta et al. or Abe et al. of the amount of treating agent used, it therefore would have been obvious to one of ordinary skill in the art to choose amount of treating agent, including those presently claimed, in order to produce composition with desired properties, or alternatively, suitable dispersability.

Given that the disclosure of Coaker et al. in view of EP 721001 and either Nitta et al. or Abe et al. discloses composition identical to that presently claimed, it is clear that such composition would intrinsically be resistant to oil as presently claimed.

In light of the motivation for using aminosilane disclosed by EP 721001 and treating agent for filler disclosed by either Nitta et al. or Abe et al. as described above, it therefore would have been obvious to one of ordinary skill in the art to use such aminosilane and treating agent in Coaker et al. order to produce composition with long pot life and excellent heat resistance and

desired mixing and molding properties as well as strength, or alternatively, good dispersability, and thereby arrive at the claimed invention.

With respect to argument (c), it is noted that neither Coaker et al., EP 721001, Nitta et al. nor Abe et al. disclose mixing chlorinated polyolefin and treated filler first followed by adding aminosilane.

However, although the manner in which the references introduce the ingredients into the composition is different than that presently claimed, given that the end result is the same, i.e. composition comprising chlorinated polyolefin, treated filler, and aminosilane, and absent evidence of criticality regarding the order of introduction of the ingredients into the composition, it therefore would have been obvious to one of ordinary skill in the art (i) to mix the ingredients in any order, including that presently claimed, and (ii) that the final composition of Coaker et al. is the same as presently claimed, and thus, one of ordinary skill in the art would have arrived at the claimed invention.

12. Claims 6-7 and 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Coaker et al. in view of EP 721001 and either Nitta et al. or Abe et al. as applied to claims 1-5 and 8-10 are above, and further in view of Schombourg et al. (U.S. 6,448,343).

The difference between Coaker et al. in view of EP 721001 and either Nitta et al. or Abe et al. and the present claimed invention is the requirement in the claims of auxiliary polymer.

Schombourg et al., which is drawn to composition comprising chlorinated polyolefin and aminosilane, disclose using porous polymer as carrier for the silane so that it is much easier to add the silane to the polymer during mixture (col.5, lines 45-52).

In light of the motivation for using auxiliary polymer disclosed by Schombourg et al. as described above, it therefore would have been obvious to one of ordinary skill in the art to use such polymer in the composition of Coaker et al. in order to produce a composition which easily mixed, and thereby arrive at the claimed invention.

13. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Coaker et al. in view of EP 721001 and either Nitta et al. or Abe et al. as applied to claims 1-5 and 8-10 above, and further in view of Ruepping (U.S. 6,346,300).

The difference between Coaker et al. in view of EP 721001 and either Nitta et al. or Abe et al. and the present claimed invention is the requirement in the claims of temperature at which extrusion occurs.

Ruepping, which is drawn to curable elastomer composition comprising chlorinated polyolefin, disclose extruding such composition at 25-250 °C in order that the composition is thermally stable during the extrusion process and does not prematurely cure (col.6, lines 42-49 and col.11, line 62).

In light of the motivation for extruding at specific temperature disclosed by Ruepping as described above, it therefore would have been obvious to one of ordinary skill in the art to extrude the composition of Coaker et al. at such temperature in order that the composition is thermally stable during the extrusion process, and thereby arrive at the claimed invention.

14. Claims 1-3, 5, 8-9, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over GB 2,016,016 in view of EP 721001.

GB 2,016,016 discloses extrudable, curable, flame retardant, oil resistant composition comprising 10-50 parts chlorinated polyolefin, 70-300 parts hydrated alumina, 10-50 parts antimony oxide, and silane coupling agent, which as seen from the examples, is present in an amount of 1-4 parts. The ingredients are mixed and then extruded at 120 °C (page 1, lines 10-11, page 1, line 57-page 2, line 1, page 2, lines 31-41, and page 3, lines 1-3, 27-29, and 55-64).

The difference between GB 2,016,016 and the present claimed invention is the requirement in the claims of (a) aminosilane and (b) order in which ingredients are mixed.

With respect to difference (a), EP 721001 discloses composition comprising chlorinated polyolefin and aminosilane in order to produce composition with long pot life and excellent heat resistance after curing (page 2, lines 9-11, page 3, lines 3-8 and 32-35, and col.4, lines 29-33). Given that the disclosure of GB 2,016,016 in view of EP 721001 discloses composition identical to that presently claimed, it is clear that such composition would intrinsically be resistant to oil as presently claimed.

In light of the motivation for using aminosilane disclosed by EP 721001 as described above, it therefore would have been obvious to one of ordinary skill in the art to use aminosilane in the composition of GB 2,016,016 in order to produce composition with long pot life and excellent heat resistance after curing, and thereby arrive at the claimed invention.

With respect to difference (b), it is noted that neither GB 2,016,016 nor EP 721001 disclose mixing chlorinated polyolefin and treated first followed by adding aminosilane.

However, although the manner in which GB 2,016,016 in view of EP 721001 introduces the ingredients into the composition is different than that presently claimed, given that the end result is the same, i.e. composition comprising chlorinated polyolefin, treated filler, and

aminosilane, and absent evidence of criticality regarding the order of introduction of the ingredients into the composition, it therefore would have been obvious to one of ordinary skill in the art (i) to mix the ingredients in any order, including that presently claimed, and (ii) that the final composition of GB 2,016,016 in view of EP 721001 is the same as presently claimed, and thus, one of ordinary skill in the art would have arrived at the claimed invention.

15. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over GB 2,016,016 in view of EP 721001 as applied to claims 1-3, 5, 8-9 and 13 above, and further in view of Coaker et al. (U.S. 5,036,121).

The difference between GB 2,016,016 in view of EP 721001 and the present claimed invention is the requirement in the claims of chalk.

Coaker et al., which is drawn to composition comprising chlorinated polyolefin, disclose the use of calcium carbonate, i.e. chalk, in order to further enhance the flame and smoke suppressant characteristics of the composition (col.11, lines 41 and 47-49).

In light of the motivation for using specific filler disclosed by Coaker et al. as described above, it therefore would have been obvious to one of ordinary skill in the art to use chalk in the composition of GB 2,016,016 in order to produce composition with enhanced the flame and smoke suppressant characteristics, and thereby arrive at the claimed invention.

16. Claims 6-7 and 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over GB 2,016,016 in view of EP 721001 as applied to claims 1-3, 5, 8-9, and 13 above, and further in view of Schombourg et al. (U.S. 6,448,343).

The difference between GB 2,016,016 in view of EP 721001 and the present claimed invention is the requirement in the claims of auxiliary polymer.

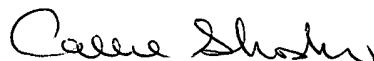
Schombourg et al., which is drawn to composition comprising chlorinated polyolefin and aminosilane, disclose using porous polymer as carrier for the silane so that it is much easier to add the silane to the polymer during mixture (col.5, lines 45-52).

In light of the motivation for using auxiliary polymer disclosed by Schombourg et al. as described above, it therefore would have been obvious to one of ordinary skill in the art to use such polymer in the composition of GB 2,016,016 in order to produce a composition which easily mixed, and thereby arrive at the claimed invention.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 703-305-0208. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 703-306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Callie E. Shosho
Examiner
Art Unit 1714

CS
10/4/02